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09/780,401	02/12/2001	John Peterson	WH-10,909US	8497

7590

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CANADA

EXAMINER

BANGACHON, WILLIAM L

ART UNIT

PAPER NUMBER

2635

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/780,401

Applicant(s)

PETERSON, JOHN

Examiner

William Bangachon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Examiner's Response*

1. In response to the application filed 2/12/01, the application has been examined. The Examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. It is the Examiner's position that claims 1-21 are unpatentable for the reasons set forth in this Office action:

### *Claim Objections*

2. Claim 7 is objected to because of the following informalities: Claim 7 recites the phrase "said to surface". It should recite, "said top surface". Appropriate correction is required.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **"electrical components and a battery supply"** as claimed in claim 1, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Specification***

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The “**electrical components and a battery supply**” as claimed in claim 1, lacks antecedent basis.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, it is unclear which area “**said area**” is being referred to since there are at least 3 areas mentioned (i.e. top surface area, adjacent area, key area).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-4 and 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,908,604 (Jacob) in view of USP 4,855,746 (Stacy).

In claim 1, Jacob teach of a key fob (18) comprising a housing enclosing electrical components and a battery supply (76) with a plurality of actuation keys (20, 22) exposed in parts of said housing, said housing having a top surface with said plurality of keys in a key area of said top surface, said key fob further including a slidable shield attached to said housing and movable from a closed position covering said actuation keys to an open position where said keys are exposed for actuation, said shield in said open position being located on said top surface {abstract; col. 2, lines 26-29}.

Jacob does not disclose expressly "an open and closed position" as claimed. In this case, Stacy is relied upon to teach of a slidable shield (18, 20) having open and closed positions for the purpose of covering and exposing different sets of keys on a remote control transmitter by movement of the slidable shield {Stacy, col. 2, lines 18-38}. The systems of Jacob and Stacy are analogous art because they are from same

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field of endeavor, remote control transmitters. The teaching of Stacy is desirable in the system of Jacob because it provides means to prevent accidental depression of the actuation keys of Jacob. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use an open and closed position, as claimed, in the system of Jacob, as taught by Stacy, because this provides means of preventing accidental depression of the actuation keys of Jacob.

In claim 2, a key fob (18) as claimed in claim 1 wherein said keys are located in a recessed area of said top surface {Jacob, as shown in figure 1; Stacy, paragraph bridging cols. 2 and 3}.

In claim 3, a key fob as claimed in claim 1 wherein said actuation keys are marginally below said top surface and said top surface is generally rectangular in top view {Jacob, as shown in figure 1; Stacy, figure 2}.

In claim 4, a key fob as claimed in claim 1 wherein said top surface has an area adjacent said key area and at least equal in size to said area such that said shield in said open position overlies said adjacent area {Stacy, col. 2, lines 20-38}.

In claim 6, a key fob as claimed in claim 1 wherein shield is movable across said top surface and in said closed position only a limited strip border area of said top surface is exposed between said actuation keys and a lower edge of said key fob and in

said open position only a limited strip border area of said top surface is exposed between said shield and a top edge of said key fob {Stacy, col. 2, lines 20-38}.

In claim 7, a key fob as claimed in claim 6 wherein said covers at least 40% of said to surface {Stacy, col. 2, lines 20-38}.

In claim 8, a key fob as claimed in claim 7 wherein said plurality of keys include at least 4 keys {Stacy, col. 2, lines 39-54}.

In claim 9, a key fob as claimed in claim 1 wherein said housing on opposed sides thereof includes two slide tracks which cooperate with said shield member to retain said shield member on said key fob and accommodate the sliding movement of said shield between said open and said closed position {Stacy, col. 2, lines 20-38}.

In claim 10, a key fob as claimed in claim 9 wherein each slide track is an elongate recess and said shield member includes on each side thereof inwardly extending slide members which are received and retained in said elongate recesses {Stacy, col. 2, lines 20-38}.

In claim 11, a key fob as claimed in claim 10 wherein said each slide track and the respective slide member cooperate to retain said shield member in said open or closed position {Stacy, col. 2, lines 20-38}.

10. Claims 12-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,908,604 (Jacob) in view of USP 4,855,746 (Stacy), and further in view of USP 5,956,625 (Hansen et al).

In claim 12 although Jacob in view of Stacy teach of a shield member, it does not disclose expressly "said shield member has a gently curved upper-surface and opposed side portions which extend downwardly and include said slide members". In this case, Hansen is relied upon to teach such features, as claimed {Hansen, figures 1-3; col. 3, lines 13-25}, for the purpose of preventing unintentional separation of parts {Hansen, paragraph bridging cols. 1 and 2}. The systems of Jacob and Hansen are analogous art because they are from same problem solving area, preventing unintentional actuation of electronic functions. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a curved shield, as claimed, in the system of Jacob because this prevents unintentional separation of parts, as evidenced by Hansen.

In claim 13, said gently curved upper surface of said shield member allows resilient flexing of said shield member and during flexing said side portions flex outwardly {Hansen, col. 4, lines 50-57}.



In claims 14 and 17, said slide tracks include stationary cam members and said slide members when forced over said cam members cause said shield member to flex with said side portions moving outwardly {Hansen, paragraph bridging cols. 4 and 5}.

In claims 15, 16, and 19, said cam members cooperate with recesses in said slide members to releasably lock said shield member in said open or closed position {Hansen, col. 5, lines 11-19}.

In claim 18, a key fob as claimed in claim 17 wherein said housing and said shield member are injection molded plastic.

Claims 20 and 21 recite the limitation of claim 12 and therefore rejected for the same reason.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,908,604 (Jacob) in view of USP 4,855,746 (Stacy), and further in view of USP 5,388,691 (White).

In claim 5, Jacob does not disclose expressly "said top surface is slightly curved across the width thereof and said curve is consistent in the length of the top surface". In this case, White is relied upon to teach of curved surfaces for the purpose of making a container attractive, comfortable to handle and less likely to show through or puncture clothing {White, paragraph bridging cols. 2 and 3}. The systems of Jacob and White are

analogous art because they are from same problem solving area, preventing accidental triggering of remote control functions. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have used curved surfaces in the system of Jacob, as claimed, because curved surfaces makes a container attractive, comfortable to handle and less likely to show through or puncture clothing, as evidenced by White.

12. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 4,908,604 (Jacob) in view of USP D461,047 (Peterson).

In claims 1-21, Jacob teach of a key fob (18) comprising a housing enclosing electrical components and a battery supply (76) with a plurality of actuation keys (20, 22) exposed in parts of said housing, said housing having a top surface with said plurality of keys in a key area of said top surface, said key fob further including a slidable shield attached to said housing and movable from a closed position covering said actuation keys to an open position where said keys are exposed for actuation, said shield in said open position being located on said top surface {abstract; col. 2, lines 26-29}.

Jacob does not disclose expressly "an open and closed position" as claimed. In this case, Peterson is relied upon to teach of a slidable shield as shown in figures 1-8. The systems of Jacob and Peterson are analogous art because they are from same field of endeavor, key fob. The teaching of Peterson is desirable in the system of Jacob because it provides means to prevent accidental depression of the actuation keys of

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Jacob. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use an open and closed position, as claimed, in the system of Jacob, as shown by Peterson, because this provides means of preventing accidental depression of the actuation keys of Jacob. Claims 2-21 are dependent claims and therefore rejected for the same reasons.

***Examiner Contact Information***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314 for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

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William L Bangachon  
Examiner  
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January 15, 2004

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read "Michael Horabik", written in a cursive style.